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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

APPLICANT: Farquhar et al. DOCKET NO: 112688-003
SERIAL NO.: 08/818,520 ART UNIT: 1733
DATE FILED: March 14, 1997 EXAMINER: S. Yao
INVENTION: "PCMCIA STANDARD MEMORY CARD FRAME"

18/3

Hon. Assistant Commissioner for Patents
Washington, D.C. 20231

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APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit, pursuant to 37 C.F.R. § 1.193(b)(1) Appellants' Reply Brief in response to the Examiner's Answer dated November 7, 2000. Appellants note that they are submitting herewith a Further Amendment After Final and a Petition with respect to the requested drawing change.

II. THE EXAMINER'S ANSWER RAISES A NEW GROUND OF REJECTION

The Examiner's Answer fails to note that it poses a new ground of rejection. In this regard, Claim 17 stands rejected under 35 U.S.C. § 112 as the Examiner states the claim recitation "the edge of the metal cover is bent" raises a new matter issue. Further, the Examiner's Answer states that it is not clear how this claim further limits Claim 11.

In the final Office Action dated April 28, 2000, Claim 17 was not specifically rejected under 35 U.S.C. § 112; indeed, the final Office Action fails to discuss Claim 17 vis-à-vis 35 U.S.C. § 112. Thus, this is a new rejection raised for the first time by the Examiner during the

appeal. 37 C.F.R. § 1.193(a)(2) states "An Examiner's Answer must not include a new ground of rejection."

Regardless, in the spirit of cooperation and to expedite what has unfortunately become a protracted and drawn out reissue proceeding, Appellants are submitting a Further Amendment After Final canceling Claim 17. Therefore, Appellants respectfully submit that this rejection is now moot.

III. AS A MATTER OF LAW, THE REJECTIONS POSED BY THE PATENT OFFICE ARE NOT PROPER

Although, at first blush a review of the Examiner's Answer suggests that resolution of this appeal will require a laborious and painstaking review of each and every claimed element, the prosecution of the parent application, the specification, and the prior art, Appellants submit that if the proper legal analysis is applied, the pending issues are easily resolved. Appellants respectfully submit that the rejections are based on a misapplication of the law regarding: 1) what constitutes new matter; and 2) the recapture rule. Appellants respectfully submit that when the proper legal analysis is adopted, that the rejections of the reissue application falls.

A. The Examiner's Answer's Application of the Law Regarding New Matter is Flawed

For all intents and purposes, the Examiner's rejection of Claims 7-14, 16-20, and 22-27 under 35 U.S.C. § 112 as based on new matter is predicated upon Appellants' attempt, in part, to broaden certain aspects of the claims. Of course, by law, Appellants are allowed to file a broadening reissue application, as this application was filed within two years of the issue date. 35 U.S.C. § 251. By definition, a broadening reissue enlarges the scope of at least certain claims.

Accordingly, whereas the only independent claim of the original patent required "a plurality of fingers extending from said sides," Appellants in the instant reissue application have submitted new claims that include instead such limitations as "at least one finger extending from a side" or "a finger extending from each of a first and second side." Whereas the original issued independent claim also included the limitation "edges of the metal cover are bent to conform to the shape of the frame," Appellants have submitted claims that instead essentially include the

limitation having an edge being bent, and means for securing the cover to the frame. There is no question that each one of these limitations is disclosed in Appellants' claimed invention.

In fact, the Examiner's Answer admits same. For example, with respect to the claim limitation "at least one finger extending from a first and a second side" the Patent Office argues that this is new matter, because the specification discloses "providing first and second sides of the metal covers with multiple fingers." See Examiner's Answer, p. 3, emphasis in original. Of course, if multiple fingers are extending from each of the sides, then at least one finger must be extending from each of the sides.

Appellants claim that a frame element is injection molded partially around the edge. The Examiner's Answer states that this is new matter because the frame element is injection molded fully around the edge in the disclosure. By definition, if the frame element is injection molded fully around the edge, the claim limitation of being injection molded at least partially around the edge is met.

With respect to the claim limitation "means for securing" the Examiner's Answer objects to this language stating that Applicants disclose specific means for securing the cover to the frame, e.g., bending edges of the cover around the frame. By definition, if Applicants disclose specific means for securing, e.g., injection molding the frame around an edge of the cover to secure the frame, then means for securing under 35 U.S.C. § 112 ¶ 6 are clearly supported.

Clearly the new matter rejections posed by the Examiner's Answer are not supported in any of the rejections. The sole basis for the rejection appears to be the belief that one is entitled to claims only as originally filed, and then only broad enough to cover the specific embodiments of the disclosure. Of course, this is not the proper test for a new matter rejection.

As the CCPA stated in *In re Rasmussen*, 211 U.S.P.Q. 323, 326 (CCPA 1981) "broadening a claim does not add new matter to the disclosure. The disclosure is that which is taught not that which is claimed." (Emphasis added.) Unfortunately, it appears that the Patent Office is taking the opposite view in the instant rejections.

In this regard, the Examiner's Answer is replete with discussions of structures that would fall within the scope of Appellants' reissue claims which are not disclosed in Appellants' specification. This is inapposite. As also noted by the CCPA in *In re Rasmussen* "that a claim may be broader than the specific embodiment disclosed in the specification in itself is of no moment. Indeed, the statutory provision for broader claims in reissue applications is intended to

meet precisely the situation in which a patentee has claimed 'less' than he had a right to claim." 211 U.S.P.Q. at 326. Likewise, the CAFC reversed a Patent Office's rejection of a reissue application that "erroneously confined [Applicant] to the specific embodiment disclosed in the original patent." *In re Peters*, 221 U.S.P.Q. 952 (Fed. Cir. 1983).

The Examiner's Answer dismisses the relevant cases stating that "the fact pattern in both of these cases [Rasmussen and Peters] may not be appropriate for the present case." Examiner's Answer p. 10-11. Appellants are not relying upon either *Peters* nor *Rasmussen* for the fact pattern. Although, as Appellants point out, the fact pattern in *In re Rasmussen* is remarkably similar to the fact pattern of the present case, rather the reason Appellants cited to these cases is they set forth the appropriate law.

Of course, a proper legal analysis requires an application of the facts to the law. In the present situation, Appellants have pointed out that broadening a claim does not add new matter to the claim. This is the law as set forth as early as 1981 by the CCPA. The next part of the analysis is then applying the facts to the law. In the present situation the Examiner's Answer admits Appellants have broadened the claims; indeed, this is why the Examiner rejects the claims as being new matter. Accordingly, the parties are in agreement, the claims, in some aspects in the reissue application, are broader than originally submitted. Applying the proper law, that broadening a claim does not add new matter, to the facts of the present situation – wherein the claims have been broadened – leads to the legal conclusion that the claims do not add new matter. Therefore, Appellants respectfully submit that the Examiner's Answer demonstrates that all of the new matter rejections are improper and accordingly should be reversed.

B. The Patent Office has Posed an Incorrect Legal Interpretation of the Recapture Doctrine

The second major legal issue that Appellants believe can be easily disposed is with respect to the recapture rejections under 35 U.S.C. § 251. Once again, Appellants respectfully submit that the Patent Office has based the rejections on an improper interpretation of the law.

With respect to the rejections based on improper recapture, Appellants respectfully submit that once again these rejections are based on a misunderstanding of the applicable law. Recently the Court of Appeals for the Federal Circuit issued an instructive decision on this issue. *In B.E. Meyers & Co. v. United States*, 56 USPQ 1110 (Fed. Cir. 2000) the court also dealt with

a situation where the patentee submitted a broadening reissue application pursuant to 35 U.S.C. § 251. As the CAFC noted, “such a broadening reissue is permitted pursuant to 35 U.S.C. § 251,” additionally the CAFC instructed and “the reissue statute is to be construed liberally. See *In re Wheeler* 790 F.2d 1576, 1579 (Fed. Cir. 1986).” In the reissue application in question in *Wheeler* the patentee deleted any reference to “pulsing circuitry in the reissue claims”. The court noted, “of course, in doing so, the plaintiff deleted the specific pulsing diode and substantial pulsing circuit limitations that had been added to its original claim to distinguish the prior art.” *Meyers* at 1116. In holding that plaintiffs deletion was not improper recapture the court stated:

Contrary to defendant’s argument, plaintiff’s deletion of the pulsing diode and substantial pulsing current limitations did not effect an improper recapture of surrendered subject matter. The subject matter protected in the new independent reissue claims dealt only with the lens system; it had nothing to do with any type of pulsing circuitry. During the original patent prosecution, the examiner made plaintiff aware that it could not receive protection for its basic pulsing circuit design because such pulsing circuitry was already taught by the prior art. In this regard, nothing changed after the reissue process. Plaintiff still cannot rely on its reissue claims to protect any type of pulsing circuit design that is taught by the prior art, and therefore plaintiff has not used the reissue process to properly recapture subject matter surrendered during the original prosecution. Accordingly, defendant’s motion for summary judgement on the recapture issue is denied, and plaintiff’s cross-motion for summary judgement on the same issue is granted.

In a similar vein, Appellants amendments are not the improper recapture of any subject matter. The Examiner’s Answer does not point to one instance wherein Appellants surrender claims such as those being presented. Although Appellants may have relied on elements that are now being removed in distinguishing over prior art references along with other elements, Appellants never admitted that any of the deleted elements were the sole basis for patentability or were required in order to distinguish over the prior art.

As the Examiner’s Answer correctly notes, to determine if a broadening reissue application is the improper recapture of subject matter previously surrendered, the entire record must be reviewed. Instead of doing this, Appellants respectfully submit that the Examiner’s Answer attempts to pull pieces of the prosecution history out of context and/or statements made by Appellants in the Appeal Brief.

As Appellants have pointed out, the addition of the limitation injection molding the plastic frame elements around the fingers did not result in the allowance of the application. Unfortunately, the Examiner’s Answer appears to suggest that this Amendment resulted in the

allowance of the claims. Instead, there was a subsequent interview with the Examiner and an Examiner's Amendment before the claims were allowed. It should be noted that none of the reissue claims that are presented have been rejected by the Patent Office in view of any prior art. This, in and of itself, demonstrates that removing the limitation "a plurality of fingers extending from each of the covers" does not render the claims unpatentable in view of the prior art. As Appellants noted, as the Examiner's Answer correctly quotes, it was not until Appellants added the limitation that the edges of the metal covers were bent to conform to the shape of the frame that the Patent Office allowed the claims.

However, contrary to the inference suggested by the Examiner, it was not the limitation that all of the edges of the metal covers must be bent to conform to the frame that resulted in allowance. Indeed, as Appellants pointed out, and the Examiner's Answer fails to note, the prior art failed to show or suggest any edge of the metal cover being bent to conform to the frame. Thus, contrary to the implication of the Patent Office, the prior art did not disclose a single finger extending from each of the edges or one cover being bent. Nor, did Applicants ever claim a single finger or only one edge of the cover being bent. Thus, Appellants have never surrendered claims such as those currently being presented. Accordingly, Appellants are not attempting to improperly recapture subject matter that was surrendered.

For the convenience of the Board, here is Claim 1 as amended by the Examiner's Amendment and as allowed:

1. A peripheral device PCB package comprising:
two stamped metal covers with a plastic frame element corresponding to each cover [wherein the metal covers are fixedly secured to the plastic frame elements]; each cover having a first side and a second side with a plurality of fingers extending from said sides and wherein edges of the metal covers are bent to conform to the shape of the frame and said fingers are embedded in the plastic frame elements forming an integral unit [with the covers], the plastic frame elements being injected molded around [a plurality of] the fingers [extending from the periphery of the metal covers];
and wherein the plastic frame element extends beyond the plane of the metal cover so that a plastic perimeter surface is exposed, thereby facilitating [the] bonding of the two covers.

As can be seen, nowhere did Appellants claim only a finger extending from a side and amend the claims to a plurality of fingers. Nowhere did Appellants claim only one side being bent and then amend the claims to claim edges of the cover being bent.

Moreover, the record indicates why the Examiner allowed the application. The Examiner in the original application allowed the claim because:

The following is an Examiner's Statement of Reasons for Allowance:

Baudouin et al discloses a plastic frame with an adhesively bonded metal cover; Leung (US Patent 5,242,310) discloses snap fitted covers; Steffen (US Patent 5,107,073) discloses unitary shells made of a plastic material; none show a device package with a plastic frame/metal cover as claimed by applicant.

See Exhibit A.

Thus, Claim 1 was not allowed because it claimed a plurality of fingers or multiple edges being bent.

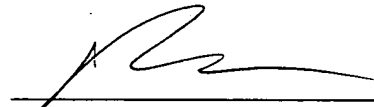
Furthermore, although the Examiner's Answer attempts to claim that some of the claimed limitations may be necessary to avoid the prior art, not one of the claims of the reissue application is rejected based on prior art! Thus, the Patent Office admits all of the claims disclose allowable subject matter. Not one of the limitations that was removed from the claims in the broadening reissue was necessary to avoid the prior art. This, in and of itself, should demonstrate that the rejection based upon improper recapture is incorrect as a matter of fact.

Thus, for the reasons set forth in Appellants Appeal Brief as well as in view of the recent CAFC decision Appellants believe that all of the rejections based on improper recapture are improper and should therefore be reversed.

IV. CONCLUSION

For the foregoing reasons Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the final rejection. Moreover, Appellants respectfully submit that the Examiner's Answer demonstrates that the rejections are based on a misapplication of the law to the facts of the present situation. Therefore, Appellants respectfully once again request that the Board of Appeals reverse the rejections.

Respectfully submitted,



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